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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,232	12/15/2003	Yuzhuo Li	2993-0115P	8618

2292 7590 05/20/2005

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,232

Applicant(s)

LI ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new matter added to the claims is the limitation added to claim 1 because the specification does not provide reasonable support for this limitation. Applicants point to page 7, lines 17-20 for support, however, this passage only supports how the particles are chosen and does **not** support the “inherency” limitation, as claimed.

The rejection based on Scott et al. and Small et al. as the primary reference (with respect to the abrasive composition and method of polishing claims **only**) have been withdrawn because the references teach polymeric particles (as argued by applicants). To the extent that any of the references define a resin particle, it is the examiners position that this is a polymeric material.

The rejection based on U.S. Patent No. 6,620,215 (Li et al.) with respect to the abrasive composition and method of polishing claims **only** have been withdrawn because the references teach polymeric particles (as argued by applicants). To the extent that the reference defines a resin particle, it is the examiners position that this is a polymeric material.

REJECTIONS:

Claims 20 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scott et al. for the same reason set forth in the previous office action which are incorporated herein by reference.

Claims 20 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Small et al. for the same reason set forth in the previous office action which are incorporated herein by reference.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chapman for the same reason set forth in the previous office action which are incorporated herein by reference.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as obvious over Chapman for the same reason set forth in the previous office action which are incorporated herein by reference.

Claims 20 and 22 are rejected under the judicially created doctrine of double patenting over claim 8 of U. S. Patent No. 6,620,215 for the same reason set forth in the previous office action which are incorporated herein by reference.

Claims 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (215) for the same reason set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 4/8/05 have been fully considered but they are not persuasive.

Applicants argue that Scott et al. and Small et al. teach polymeric particles. The examiner acknowledges that the Scott et al. and Small et al. use polymeric particles and not the claimed "non polymeric organic particles" in the polishing method, however, applicants are claiming a substrate prepared by using this process and it is well established that the use of process limitations to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, how does the substrate differ when polishing using (1) the claimed method compared to polishing using (2) a method which employs a polymeric particle? If applicants argue this point, they must show comparative evidence that clearly shows that a different substrate is produced using the claimed method compared to the method of the references.

Applicants argue that Chapman is referring to melamine urea formaldehyde resin (i.e. polymers) and not melamine particles (page 13 of the response). Applicants make an assumption that the passage "melamine, urea formaldehyde resins" of the reference is referring to the combination of melamine and urea formaldehyde to form a resin. It would appear that applicants are completely ignoring the comma between melamine and urea formaldehyde resins when this assumption is made. In view of this, the reference clearly teaches that the abrasive can be melamine and this is a non polymeric organic material (specific material claimed by applicants),

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thus it can inherently have the added property, as claimed, absent evidence to the contrary. If applicants continue to argue the above point, as defined in the response, they are requested to submit evidence as to why applicants assumption is correct.

Applicants argue the ODP rejection based U.S. Patent No. 6,620,215, however, claims 20 and 22 are obvious because applicants are claiming a substrate prepared by using the claimed process and it is well established that the use of process limitations to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, how does the substrate differ when polishing using (1) the claimed method compared to polishing using (2) a method which employs a polymeric particle? If applicants argue this point, they must show comparative evidence that clearly shows that a different substrate is produced using the claimed method compared to the method of the prior patent.

Applicants argue that Li et al. (215) teach polymeric particles. The examiner acknowledges that this reference uses polymeric particles and not the claimed "non polymeric organic particles" in the polishing method, however, applicants are claiming a substrate prepared by using this process and it is well established that the use of process limitations to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, how does the substrate differ when polishing using (1) the claimed method compared to polishing using (2) a method which employs a polymeric particle? If applicants argue this point, they must show comparative evidence that clearly shows that a different substrate is produced using the claimed method compared to the method of the reference. Applicants also argue that this reference is disqualified

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as prior art under 35 USC 103 (C) in view of the statement of common ownership. The examiner acknowledges this statement, but as correctly stated by applicants, this statement disqualified this reference as art under 35 USC 103 (C). To the contrary, the examiner relied on this art in a **102 rejection and not a 103 rejection (how does this statement disqualify this reference as art under an anticipatory rejection especially since this statement is only good for an obviousness rejection?)**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

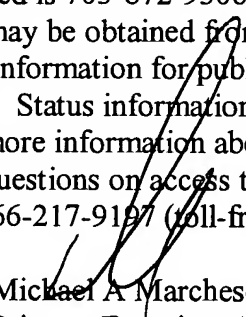
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/05

MM


Michael A. Marcheschi
Primary Examiner
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